

d) claims 9, 10, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over pages 1-5 of the specification and figures 9 and 10 of the specification in view of United States Patent Number 4,535,542 to Sebelist et al. (hereinafter Sebelist et al.).

e) claims 11-14 and 16-54 are withdrawn as being drawn to a nonelected invention.

3. Point 12 of the Office Action Summary dated December 23, 2004, indicates that although a claim of foreign priority has been acknowledged, none of the certified copies of the priority documents have been received. However, as described below, a certified copy of the priority document was properly filed with the United States Patent and Trademark Office.

Attached hereto as Exhibit A is a copy of a submission that applicant made to the U.S. Patent and Trademark Office entitled "Claim For Foreign Priority And Submission of Certified Copy Pursuant to C.F.R. § 1.55." This submission was mailed to the United States Patent and Trademark Office, and has a Certificate of Mailing dated December 31, 2001, and the Certificate of Mailing was signed by Janice Capuani. Attached to this submission was the certified copy of the priority application, as indicated. Pursuant to 37 C.F.R. §1.55(a)(1), this December 31, 2001 submission also included the serial number of 2000-317862 and filing date of October 18, 2000, of the Japanese priority application.

Also, the first two lines of the December 31, 2001 submission clearly state the following: "Attached is a certified copy of Japanese patent application 2000-317862 filed October 18, 2000."

This submission was mailed with a self addressed stamped return postcard. The U.S. Patent and Trademark Office date stamped the return postcard and mailed it back to applicant. Applicant attaches a copy of the postcard that was returned by the U.S. Patent and Trademark Office. As shown, the post card is date stamped January 28, 2002. Also, this postcard indicates the following:

"The U.S. Patent and Trademark Office date stamp hereon will acknowledge receipt of:  
a Preliminary Amendment;  
a transmittal letter enclosing a certified copy of the priority document (Japanese Patent Application No. 20000-3137862"

Importantly, because this postcard was date stamped by the U.S. Patent Office and returned to applicant, the U.S. Patent Office has already acknowledged receipt of the certified copy of the priority application.

Therefore, applicant's submission of December 31 2001 clearly stated that the priority application was enclosed, and the U.S. Patent and Trademark Office acknowledged receipt of the certified copy of the priority application, as shown by the date stamped postcard.

Hence, it appears that there can be no dispute that that as of January 28, 2002 the U.S. Patent and Trademark acknowledged that it had possession of the certified copy of the priority application. Therefore, applicant respectfully requests that it not be penalized for what clearly appears to be a U.S. Patent Office mistake.

In addition, applicant points out that the certified copy of the priority document was filed with the U.S. Patent and

Trademark Office at a time when there were widespread states of alarm with respect to mail.

Given the above, applicant respectfully requests the Examiner reconsider this issue and withdraw the indication that "none of the copies of the priority documents have been received," and forward a corrected Office Action Summary that indicates that "all of the priority documents have been received."

4. In point 2 of the Office Action the Examiner indicates that the information disclosure statement lacks a concise explanation of each reference not in the English language. What follows is an explanation of the relevance of the references not in the English language:

DE 19843 011 A

EP 0 584 602 A

DE 19843 011 A discloses an apparatus for cutting four sides of stacked sheets. The apparatus disclosed in D1 comprises a receiving station; an alignment station; an alignment means arranged in the alignment station; a conveying means for conveying the stacked sheets from the receiving station to the alignment station; a cutting station for cutting the top edge, bottom edge and fore edge of the stacked sheets; a chuck mechanism for holding the stacked sheets in the vertical direction and conveying the stacked sheets from the alignment station to the cutting station; a cutting table arranged in the cutting station for supporting the stacked sheets thereon; a top edge cutting knife arranged in the cutting station for upwardly and downwardly movement so as to cut the top edge of the stacked

sheets; a bottom edge cutting knife arranged in the cutting station for upwardly and downwardly movement so as to cut the bottom edge of the stacked sheets; a fore edge cutting knife arranged in the cutting station for upwardly and downwardly movement so as to cut the fore edge of the stacked sheets; a pressing plate arranged in the cutting station for upwardly and downwardly movement between a waiting position, which is positioned over the stacked sheets, and a working position where the pressing plate presses the stacked sheets to the cutting table; and a driving mechanism for upwardly and downwardly moving the pressing plate.

EP 0 584 602 A discloses the features of measuring a distance between the pressing plate and the stacked sheets while the pressing plate is rising off the stacked sheets after cutting operation of the stacked sheets, and adjusting the waiting position of the pressing plate to a height level correspondingly with the height of the stacked sheets for the next cutting operation.

However, DE 198 43 011 A and EP 0 584 602 A fail to disclose the first features of measuring the height of the stacked sheets prior to placement of the stacked sheets on the cutting table and adjusting the waiting position of the pressing plate to a height level correspondingly with the height of the stacked sheets and moving the pressing plate upwardly and downwardly between the adjusted waiting position and the working position, and the second feature of measuring the height of the stacked sheets while conveying the stacked sheets from the receiving station to the alignment station by the conveying means so as to adjust a distance between a movable portion and a

fixed portion of the chuck mechanism prior to its clamping operation. They also fail to disclose measuring the height of the stacked sheets when they are held by the chuck mechanism and adjusting the waiting position of the pressing plate to a height level correspondingly with the height of the stacked sheets prior to placement of the stacked sheets on the cutting table, and moving the pressing plate upwardly and downwardly between the adjusted waiting position and the working position.

5. In point 3 of the Office Action the Examiner objects to the Abstract because of its length. On the following page is an amended marked-up Abstract of the Disclosure that does not have more than 150 words. Words underlined are being added, words with a strikeout line through them are being deleted. Accordingly, applicant respectfully requests that the objection to the Abstract of the Disclosure be withdrawn.